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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/509,319	09/27/2004	Martin Roth	75248-034	1908
21890	7590	09/18/2008		
PROSKAUER ROSE LLP PATENT DEPARTMENT 1585 BROADWAY NEW YORK, NY 10036-8299			EXAMINER KRUEER, KEVIN R	
			ART UNIT	PAPER NUMBER
			1794	
			MAIL DATE	DELIVERY MODE
			09/18/2008	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

**Application No.**

10/509,319

**Applicant(s)**

ROTH ET AL.

**Examiner**

KEVIN R. KRUEER

**Art Unit**

1794

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 6/28/08.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) 9-16 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/CB/CIC)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_
- Paper No(s)/Mail Date \_\_\_\_\_

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on June 26, 2008 has been entered.

### **Election/Restrictions**

1. Claims 9-16 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on May 26, 2006.
2. Applicant's election with traverse of group I in the reply filed on May 26, 2006 is acknowledged. The traversal is on the ground(s) that the search would not be an undue burden. This is not found persuasive because the inventions are classified in different classes and each invention requires a distinct set of classes/subclasses to be searched.

The requirement is still deemed proper and is therefore made FINAL.

### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hoffmann et al (US 4,806,450) in view of Kawase et al (US 5,753,362).

Hoffmann teaches a coating composition comprising a (meth)acrylic copolymer having a molecular weight of 15,000-500,000 (col 3, lines 37+) and an OH value of 20-100mg KOH/g (col 3, line 10). The copolymer comprises (meth)acrylic acid, (meth)acrylate, and hydroxylalkyl (meth)acrylate, wherein some of the carboxyl groups of the copolymer are esterified by reaction with glycidyl (meth)acrylate (abstract), preferably 10-60% (col 3, line 6). The copolymer comprises 8-30wt% acrylic acid (abstract).

Hoffmann does not teach that the reaction product should further comprise an unsubstituted phenol such that the phenol to (meth)acrylic ester ratio is within the claimed range. However, Kawase teaches a methacrylic acid copolymer may have its glass transition temperature optimized by utilizing a phenol methacrylate such as benzyl methacrylate (col 13, lines 18+). Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to polymerize benzyl methacrylate into the polymer taught in Hoffman in the claimed relative amounts in order to optimize the glass transition temperature of the coating.

With regards to claim 8, it is known that the molecular weight of a polymer affects its processability. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to optimize the molecular weight of the polymer taught in Awokola in order to optimize the processability of the composition.

***Response to Arguments***

Applicant's arguments filed 6/26/2008 have been fully considered but are not persuasive.

Applicant argues that there is no teaching or suggestion in the cited publications to make the proposed combination and arrive at the presently claimed invention. Specifically, applicant argues there is no mention made of adding additional monomers to the copolymer composition of Hoffmann. The examiner agrees but notes Hoffman was never relied upon for said teaching. Rather, Kawase was relied upon to motivate the skilled artisan to add component C to the composition of Hoffman. Said alteration would have been obvious because Hoffmann teaches the film is preferably solid at room temperature (col 7, lines 55+). The skilled artisan would have known that it is desirable to further control the glass transition temperature of a film in order for said film to be easily processable and useful for its intended use. Thus, the examiner maintains the position that it would have been obvious to utilize the phenol methacrylate to optimize the glass transition of the film taught in Hoffman in order to obtain the desired room temperature characteristics and processing properties.

Applicant argues the skilled artisan would have no reasonable expectation that the influence of benzyl (meth)acrylate has on the glass transition temperature in the matrix of Kawase would be the same in the different matrix of Hoffmann. Said argument is not persuasive because the effect of monomer selection and amount on glass transition temperature is well established in the art. Applicant argues there is no way to predict how incorporating benzyl (meth)acrylate into Hoffman will effect the copolymer'

performance. Applicant does not explain what properties the skilled artisan would expected to be affected-only that the resulting combination does not have the requisite level of predictability. The examiner respectfully disagrees. As noted above, the affect on the glass transition temperature is easily predicted by the skilled artisan. Furthermore, the examiner cannot identify any essential characteristic of Hoffman which may be impacted negatively or unpredictably. Furthermore, while Kawase teaches too much benzyl (meth)acrylate will affect the desirable properties of the copolymer, said affect is a predictable one-reduction in monomers having functional groups. Thus, there is nothing in either reference or the prior art as a whole that suggests said addition will have unpredictable effects.

For the reasons noted above, the rejections are maintained.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to KEVIN R. KRUER whose telephone number is (571)272-1510. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rena Dye can be reached on 571-272-3186. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Kevin R Kruer/  
Primary Examiner, Art Unit 1794

**Application Number****Application/Control No.**

10/509,319

**Examiner**

KEVIN R. KRUEER

**Applicant(s)/Patent under  
Reexamination**

ROTH ET AL.

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